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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ULRICH REICHSTEIN,
OSWALD DACHS, GERD WARNECKE,
BODO STANGE, and
MATTHIAS KANTER

Appeal 2007-3364
Application 10/603,459
Technology Center 1700

Oral Hearing Held: December 18, 2007

Before CHUNG K. PAK, CATHERINE Q. TIMM, and
JEFFREY T. SMITH,
Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

HENRY M. FEIEREISEN, ESQUIRE
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Reported by:

Sean Williams

3

1 CLERK: Calendar Number 6, Appeal Number
22007-3364. Mr. Feiereisen.

3 JUDGE PAK: Mr. Feiereisen.

4 MR. FEIEREISEN: Feiereisen.

5 JUDGE PAK: You have 20 minutes.

6 MR. FEIEREISEN: Yes. Good afternoon. Okay.

7 JUDGE PAK: You may start any time you wish.

8 MR. FEIEREISEN: Okay, thank you. Let me first make a
9point with respect to German Utility Model Number 20204359, of which the
10examiner provided only the -- graphic sheet data sheet, together with an
11abstract and the drawings, but not a copy of the underlying document. The
12-- graphic sheet indicates a publication date of
13June 6th, 2002, which would render this document prior art under 102(b).

14 However, in preparation for this hearing, I retrieved the actual
15document and it turns out that the publication date of the document is in fact
16July 11th, 2002. June 6th, 2002 refers to the registration date of that utility
17model. So that reference is actually not a reference applicable under 102(b).

18 JUDGE PAK: Do you know when that form reference is
19available to the public, the registration date --

20 MR. FEIEREISEN: Yes, July 11th. I have a copy here. I
21mean, I never doubted the accuracy of the -- graphic sheet, but then I figured
22-- well, I tried to verify it and it really turned out that -- can I show it to you?

23 JUDGE PAK: Yes, you may approach the bench.

24 JUDGE PAK: This is the -- graphic sheet where it says June
256th. It's in German, but this part refers to the publication. It's a utility model
26that is not being examined. It's a registration process and they get registered

1first after the application and then subsequently -- so it's not -- it's called an
2-- so I can leave you this.

3 JUDGE TIMM: So when it's registered, it's not available to the
4public --

5 MR. FEIEREISEN: No.

6 JUDGE TIMM: -- at that point?

7 MR. FEIEREISEN: It's still in secret and then it's public.

8However, you can be provided rights from that -- so you wouldn't be having
9it under 102(b), but that does not apply here today.

10 JUDGE TIMM: Um-hum.

11 MR. FEIEREISEN: Okay, it would also not be actually prior
12art under 102(a) once I file a translation of the priority document, which I
13will file, if, for some reason, we continue this process here. Okay, with
14respect to the rejections under 112, the first and second paragraph, there are
15two interrelated contentious issues: one, whether the internal, although not
16expressly mentioned, is nevertheless inherently disclosed in the
17specification, which would be sufficient under 35 U.S.C. 112; the second
18issue would be the meaning of the word on. With respect to internal, the
19appeal brief referred to several paragraphs in the specification described --
20that described the arrangement of the machine control and electric
21components on the machine or various parts of the machine.

22 In addition, the specification specifically refers to external parts
23and thus makes a distinction between external parts and other parts.
24Paragraph 3, and in particular Paragraph 11, expressly refer to the use of an
25external device which is linking in wireless mode to the machine control.
26Therefore the reference to machine control clearly implies that the machine

1control, as well as other elements, have to be internal, unless components are
2expressly designated external.

3 JUDGE PAK: What was your argument again?

4 MR. FEIEREISEN: Since the specification expressly uses the
5word external. It doesn't use the word internal, but it specifically refers to
6external. Then the other parts that are mentioned cannot be external but
7must be something else. And Claim 4, in that respect, I want to specifically
8mention to that, because it sets forth the provision of an external device.
9And under the doctrine of claim differentiation, it is well established that the
10presence of a dependent claim that adds a particular limitation, raises a
11presumption that the limitation in question is not found in the independent
12claim. That presumption is especially strong when the limitation in dispute
13is the only meaningful difference between the independent and dependent
14claim.

15 JUDGE PAK: Counsel, you are relying on inherency.

16 MR. FEIEREISEN: Right.

17 JUDGE PAK: Am I correct?

18 MR. FEIEREISEN: Correct.

19 JUDGE PAK: Do you know what the standard for inherency
20is?

21 MR. FEIEREISEN: Well, it has to -- the specification has to
22reasonably convey to an artisan that claim limitation, even though it may not
23be expressly set forth.

24 JUDGE PAK: I think you are incorrect. Inherency means that
25the disclosure provided in the application must necessarily --

26 MR. FEIEREISEN: Right.

15

1 JUDGE PAK: -- resulted in the outcome that you are now
2claiming.

3 MR. FEIEREISEN: Right.

4 JUDGE PAK: You must necessarily.

5 MR. FEIEREISEN: Well, and I think it does, because by
6expressly setting forth external elements to distinguish these elements from
7other elements, then these other elements must be -- in combination with the
8word on that is described in the specification. So I think, if you include, for
9example, the KSR decision, which affirms the recourse to common sense, or
10some fantasy to the artisan, I think an artisan who reads the specification
11reasonably knows that these parts that are not expressly set forth as external
12are internal parts.

13 Okay, with respect to Claim 4, I think, under the claim
14differentiation aspect, also, if you -- if Claim 4 wouldn't add anything else,
15then Claim 4 would add nothing to Claim 1 and the two claims would
16effectively cover identical subject matter, if the examiner's position is taken.
17With respect to the use of the word on, the specification is clear on this
18point, that the elements involved are part of the machine and cannot be
19interpreted as being near the machine, as the examiner appeared to have
20implied. As stated in the en banc Phillips decision by the CAFC (phonetic
21sp.), claims are part of the specification and thus must be read in view of the
22specification. The intrinsic --

23 JUDGE SMITH: Excuse me. Why doesn't Claim 4 refer to an
24additional external device? It wouldn't be improper to read that as adding an
25additional external device or a control unit that's external of the machine.
26For example, you have a control unit that's connected to the machine, and

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1 then you have a cell phone that's connecting to the control unit that's
2 connected to the machine.

3 MR. FEIEREISEN: Can you say that -- Claim 4 specifically
4 refers, and the specification specially refers, to an external device. And it
5 does say in the specification that the machine control and electric
6 components operating terminal are on the machine part, on various machine
7 parts of the machine.

8 I do not think you can separate the machine control out of that
9 context and then consider this also an external device that may have -- they
10 may be linked wirelessly to an external device. So I do think that Claim 4 is
11 specifically also under the consideration of the claim differentiation aspect.
12 It's a separate device that is external, to differentiate external vis-a-vis
13 internal.

14 JUDGE SMITH: Yes, but I'm saying, for example, the
15 reference that you're discussing regarding the data publication, the drawing
16 that appears on the last page of it shows a computer that's external to the
17 machine and --

18 MR. FEIEREISEN: Which reference are you --

19 JUDGE SMITH: The DE20204359 reference, the reference
20 that the examiner cited for the abstract. You said you had a copy of it.

21 MR. FEIEREISEN: That's the one I was referring to in the
22 beginning. Well, I don't think it's prior art.

23 JUDGE SMITH: Well, this will explain my point. Refer to the
24 drawing, the left Figure 2 in that drawing --

25 MR. FEIEREISEN: Figure 2?

26 JUDGE SMITH: Figure 2.

1 MR. FEIEREISEN: Yeah.

2 JUDGE SMITH: And you notice what appears to be a laptop
3computer and it's external, Number 20. Operatively connected by Number
419, which appears to be external -- and you'll also notice that there appears
5to be some type of cell phone or some other device and they can have signals
6going to it. Both of those devices are external, so there's going to be
7additional external information.

8 MR. FEIEREISEN: Yes, in the prior art. Also, the other
9references have external devices, like a laptop, like printers, like PC, as we
10do too, as far as PC and printer is concerned.

11 JUDGE SMITH: How does that necessarily indicate that Claim
124 requires that the other component be internal?

13 MR. FEIEREISEN: Because then, otherwise, what does Claim
144 add?

15 JUDGE SMITH: It adds an additional external device.

16 MR. FEIEREISEN: Why then say external? Why then
17specifically refer to the word external if you ignore it and read it into Claim
181? I don't think -- then, again, I think this is, this is where the doctrine of
19claim differentiation comes into play. I mean, I must have said something in
20Claim 4 that differentiates

21Claim 4 from Claim 1. And also, if you take Claim 3, Claim 3 --

22 JUDGE SMITH: So you said that an additional external
23component doesn't differentiate from one external component. So two
24doesn't differentiate from one is what you --

25 MR. FEIEREISEN: I'm saying that Claim 4 adds something to
26Claim 1, limits further Claim 1. And I have in Claim 3, for example, a

1listing of those electrical components that are consideration internal. So if I
2have then Claim 4 that specifically refers to external, then there's again no
3reason to have this Claim 3. But why not simply put it in Claim 3, that lists
4the other components, the electrical components that are set forth in Claim
51? So the reference to external, in my view -- and I do think an artisan who
6reads that would interpret this as an external element, while the others are
7internal elements, and that's the crux of -- the essence of the invention, to
8have everything inside so you have wireless communication inside the
9machine or as part of the machine.

10 And I don't think you can incorporate this -- the reference to
11external in Claim 4 into Claim 1. I mean, there must be a reason why it's set
12forth. It's named and it's labeled external. If it doesn't make any difference,
13then Claim 4 makes -- doesn't add anything. It would cover the same thing
14as is in Claim 1 and it would not need Claim 3.

15 JUDGE PAK: Counsel, we understand your position.

16 MR. FEIEREISEN: Okay.

17 JUDGE PAK: Let's move on. You only have about 10 minutes
18left.

19 MR. FEIEREISEN: Let me just see. Again, I wanted to refer
20to the KSR decision, because they made a point of having common sense,
21expanding it a little bit. I think that comes into play here, too, that an artisan
22with common sense would read this in a way that there are parts that are
23external, there are parts; the machine control and the electric components
24that are in Claim 1 are the internal parts. And if internal is the proper
25interpretation, I think then the prior art, it reads over the prior art. I mean,
26none of the prior art has a machine control, as well as electronic

1components, as part of the machine, inside the machine, internally
2communicating wirelessly. That's actually -- that's all I have to say.

3 JUDGE SMITH: Is that your complete argument? You're not
4going to address the prior art?

5 MR. FEIEREISEN: Again, the prior art, if you have Latham,
6they have a controller that is part of the machine, but it doesn't say anything
7about a communication between the workstations or the transducers, how
8they communicate with the controller. It has also a remote device, a remote
9site computer. That's the Latham reference.

10 The other German reference has a laptop, so you have an
11external device where the machine control is also externally. And the
12European has just a network server, an essential server, that communicates
13with various other machines. But again, it doesn't relate to the
14communication of components of one machine and one control inside that
15one machine. So they all have external machine controls. And I think the
16main argument by the examiner has been the internal and the way he read --
17interpreted the internal and on. He then conclude that all of these prior arts,
18because you put it in a room and the room is in proximity, that would read
19on Claim 1.

20 JUDGE SMITH: --Hasn't that's been recognized in the prior
21art, the use of wireless technology to replace cables?

22 MR. FEIEREISEN: Yes, and they use it in the prior art. But
23again, no -- not internally in the machine. That's the novel aspect here. The
24control, the machine control is also integrated in the machine, and wireless
25communication with internal electrical components. So you don't have a

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1separate unit, a separate PC, a separate control mechanism, outside that
2machine.

3 JUDGE SMITH: What type of dimensions are we talking
4about on this machine?

5 MR. FEIEREISEN: Dimensions. I mean, some of those
6injection molding machines are very -- I mean, as broad as this desk. It
7depends.

8 JUDGE SMITH: So it's going to be a relatively large machine?

9 MR. FEIEREISEN: Considerably, yes. Yes.

10 JUDGE SMITH: So the prior art, I believe, discusses the
11removal of cables to increase flexibility.

12 MR. FEIEREISEN: Correct. That's the Latham reference. I
13think that makes a point of removing wiring and they do it by having the
14outside wiring removed by having the PC or laptop on the outside and have
15a wireless communication with the machine.

16 JUDGE SMITH: Okay. Have you provided the analysis of
17what your means for transmitting and receiving electrical waves is?

18 MR. FEIEREISEN: Oh, these -- this Bluetooth technology.
19This is all known technology. Bluetooth, whatever is described here, as an
20example, with the thermal temperature sensor, these are the Bluetooth
21technologies. That's not what the essence is of the invention. That
22technology's wireless technology is known. So we're not claiming any
23aspect of how to implement the wireless communication and how it's done.
24I think we also say, in the specification, that it's generally known to the
25artisan. So that's why Claim 2, for example, has been rejected by the
26examiner, also, in the -- prior art, which refers to the technology.

1 JUDGE TIMM: So is there --

2 MR. FEIEREISEN: So it's really the idea to --

3 JUDGE TIMM: Is there a place in your specification that you
4can turn to that describes the instruction that corresponds to that means for
5transmitting and receiving? The language.

6 MR. FEIEREISEN: Oh, yeah, I think so. Let me just -- I think
7the description was Figures 2 and 3. That's on -- uses the example of the
8temperature sensor, which describes the technology that is used to do that.

9 JUDGE TIMM: Well, the means for transmitting and receiving
10electromagnetic waves would be the Bluetooth technology, correct? Would
11that be the wireless communication through the use of the signal converters
12and antennas?

13 MR. FEIEREISEN: I mean, again, this paragraph, 18 -- 17
14refers to a suitable wireless technology that includes Bluetooth wireless
15specification. It's used as an example for transmitting and receiving
16electromagnetic waves. Again, we're not trying to get protection for that
17technology. It is only the idea to incorporate everything in one machine, and
18the artisan, once he knows that, would easily implement it with the available
19technology. But it's really just to have -- and the prior art doesn't have that.
20I mean, if you read the prior art, they use wireless communication, but not
21the way that is conveyed in this specification. That's as far as --

22 JUDGE SMITH: Do you have anything further, Judge Pak?

23 JUDGE TIMM: Any more questions?

24 JUDGE PAK: Thank you for coming.

25 MR. FEIEREISEN: Thank you for listening. Do you want me
26to provide a copy of that German reference?

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1 JUDGE SMITH: No, we'll be able to get a copy.

2 MR. FEIEREISEN: Okay.

3(Whereupon, the proceedings concluded.)